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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Advisory Action	**Application No.** 09/517,818	**Applicant(s)** OZ ET AL.
		Examiner Johnny Ma	**Art Unit** 2614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

<u>PERIOD FOR REPLY</u> [check either a) or b)]

a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on <u>20 October 2003</u>. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *(see attached)*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: _____.

    Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 10/20/2003 have been fully considered but they are not

persuasive.

2.   In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding claim 23, applicant

argues "neither Grossman, Picco, or Kitsukawa discloses an operation of 'periodically

downloading from a server selected data sets according to user profile information, the selected

data sets representing information elements for display to a user during switching events."

Specifically, applicant argues "[a]lthough Picco discloses a plurality of content profiles that

match some predetermined criteria (Picco 8:10-15), and downloading private data to each set-top

box by a trickle, i.e. background, download technique, a nightly download technique or a dual

receiver technique (Picco 9:1-3), the downloaded private data is not "for display to a user during

switching events", as required by claim 23. In contrast, the local content in Picco is inserted into

the programming data stream (Picco 6: 20-23, 38-40), as opposed to 'during switching events' of

claim 23." However, the display to a user during switching event is a natural result of the

Grossman and Picco combination where the Picco advertisement method is combined with the

displaying of advertisements during a channel change, a switching event.

3.   Similarly, regarding applicant's argument that "[n]either Grossman nor Picco discloses

an operation of 'discontinuing the display of the first one of the information elements and

displaying the data stream information from the server when it becomes available for such

display, unless the user has initiated an interactive transaction session with a remote host by

selecting an interactive element associated with the first one of the information elements in

which case displaying the data stream information from the server is delayed until termination of

the interactive transaction session or expiration of a predetermined period of inactivity by the

user." Note, the Grossman et al. reference discloses displaying advertisements during a channel

change where the display of the advertisement is discontinued when the second channel becomes

available. This is supported by the Grossman et al. reference where:

> *When a user of a conventional subscriber unit changes channels there is normally a brief*
>
> *period between the displays of sequentially displayed channels on the television receiver*
>
> *of the conventional subscriber unit. The delay period can typically have a duration of*
>
> *approximately three hundred milliseconds to approximately five hundred milliseconds*
>
> *and is some-times referred to as the interchannel interval (ICI). In the preferred*
>
> *embodiment of the present invention the visual image from the cable headend is*
>
> *displayed on television receiver 30 during the ICI (Grossman et al. 3:46-55).*

The display of advertisements during the ICI as disclosed satisfies the claimed "discontinuing the

display of the first one of the information elements and displaying the data stream information

from the server when it becomes available for such display." Furthermore, "unless the user has

initiated an interactive transaction session with a remote host by selecting an interactive element

associated with the first one of the information elements in which case displaying the data stream

information from the server is delayed until termination of the interactive transaction session or

expiration of a predetermined period of inactivity by the user" is a natural consequence of the

combination of the Grossman et al. advertisements and the Kitsukawa et al. interactive

advertisements where, as stated in prior Office Action, Kitsukawa et al. discloses the coupon

information may be displayed by superimposing the information over the broadcast of the

television program on the screen (Kitsukawa et al. 11:24-26) where a delay of the display of the

data stream information until termination of the interactive transaction would be inherent to the

Grossman et al. and Kitsukawa et al, combination since the coupon information would obstruct

program display until display of coupon information is completed.

In response to applicant's argument that there is no suggestion to combine the references,

the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, in the knowledge generally available to one of ordinary skill in the art. The Picco

reference was relied upon for its teaching of personalized advertisement presentation.

Furthermore, as cited in rejection of claim 23 in the previous Office Action, the Grossman et al.

reference also discloses for example, the header information associated with an image can

include the duration and frequency of display of the image as well as identification information.

The identification information can include telephone, address, internet address, web page

address, facsimile or telex information associated with an advertiser where it is clear that the

Grossman et al. interchannel images are advertisements. The motivation is found in the

knowledge generally available to one of ordinary skill in the art for the purpose of providing

advertisements during channel changes that users may be interested in, as cited in previous

Office Action.

Applicant further argues, "[e]ven if such teachings were combined, there is no reasonable

expectation of success, because in Picco the local content is inserted into the programming data

stream only when the local content space is identified within the compressed digital data stream

(Picco 6: 20-23, 38-40), and thus displaying a local content in Picco is dependent on the

availability of the local content space within the compressed digital data stream." The examiner

respectfully disagrees, please see the response above in regard to attacking references

individually where the rejections are based on combinations of references.

Regarding applicant's assertion that "it is questionable whether one of ordinary skill in

the art would have realized that such use of information elements with interactive elements could

have been adapted for use in the system taught by Grossman." Although applicant correctly

argues that there is no indication in Grossman that information displayed when the user changes

channels is in any way dependent on or related to the content of the television picture, the

examiner disagrees with applicant's assertion that "Kitsukawa, on the other hand, is concerned

with displaying information directly related to the content of the television picture, i.e., providing

coupon information for products and services used in the scenes of television programs. Thus,

one of ordinary skill in the art would not have been motivated to make the combination

suggested by the examiner because the references themselves do not suggest such a combination

and the problems being addressed therein are not at all similar" The Kitsukawa reference

discloses, and as cited in prior Office Action, providing coupon information for items comprising

products and services where "[t]he products and services may be used in scenes of live and

prerecorded television programs and live and <u>prerecorded television commercials</u>, wherein the scenes comprise <u>currently displayed scenes</u>, previously displayed scenes, and scenes that are to be displayed in the future" which is clearly also relevant to an advertisement currently displayed on a screen. The Kitsukawa et al. reference discloses a method for providing users with additional information about advertised products or services displayed in commercials. Also note, the Grossman et al. reference clearly discloses the use of advertisements during an interchannel period (Grossman et al. 7:29-39). Thus the examiner submits that, as stated previously, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Grossman et al. zap time with the Kitsukawa et al. interactive session for the purpose of providing advertisements with readily accessible supplementary information or direct purchasing to the viewer. Furthermore, it is unclear why a modification to the Grossman et al. advertisements with the Kitsukawa advertisement interactivity would not be successful.

Regarding claim 31, applicant argues "[n]either Grossman, Picco, or Kitsukawa discloses 'a set top box configured to periodically download from the selected data sets according to user profile information, the selected data sets being included within the data stream and representing information elements for display to a user during switching events.'" The examiner respectfully disagrees, as cited in prior Office Action Paper No. 10, the Grossman et al. reference also discloses a digital set top box where the signals representative of the visual image transmitted from cable headend 12 can be analog or digital signals, although digital signals are preferred (Grossman et al. 6:55-57) which satisfies the set top box requirement. Furthermore the set top box configured to periodically download from the selected data sets according to the user profile

information is met by the Grossman et al. and Picco et al. combination where Picco et al. teaches

selected data sets according to user profile information where in accordance with the invention,

the pieces of local content downloaded to the set-top box may have a plurality of different

content profiles and only the pieces of local content with content profiles that match some

predetermined criteria stored in the set-top box are stored in the set-top box (Picco et al. 8:10-15)

where the Picco et al. reference discloses local content such as advertisements (Picco et al. 6:60-

61). Furthermore, note that "private data may be downloaded to each set-top box by a trickle,

i.e., background, download technique, a nightly download technique or a dual receiver technique

(Picco et al. 9:1-3) where private data includes the advertisements (Picco et al. 8:29-32) where a

nightly download meets the periodic download requirement. "The selected data sets being

included within the data stream" was met by the Picco et al. teaching of a broadcaster serving

local content and data streams where the server is inherently configured. Specifically, "[t]he

nightly download technique downloads all of the private data to the set-top box each night while

the set-top box is probably not being used for viewing television. This technique may be faster

than the trickle technique since the private data may use an entire channel of the satellite to

download the public data. " where it is understood that other channels in the broadcast are

assigned to programming and one channel is assigned to commercial downloading where the

examiner interprets the satellite broadcast channels to constitute a data stream where the one

channel of advertisements is within said data stream. The claimed "representing information

elements for display to a user during switching events" was met by the Grossman et al. and Picco

et al. combination where the Picco et al. advertising method was combined with the Grossman et

al. zap time where advertisements would be displayed during channel changes as a natural

consequence of such a combination.

As to claims 5, 32, and 33; applicant argues "[s]pecifically, Nathan disclosure relates to

home digital audiovisual information recording and reproduction apparatus (Nathan 1:29-30),

which allows the user to select and purchase a musical piece (Nathan: 12: 8-19). Grossman, on

the other hand, is concerned with displaying advertising information in response to the

determination of a channel change (Grossman 2: 37-40). However, examiner respectfully

disagrees. Although Grossman is generally disclosed with the presentation of advertising

information in response to a channel change, the Nathan and Grossman combination was based

on the presentation of media stored in memory to a user. As cited in the prior Office Action

the Grossman et al. reference also discloses in addition to receiving to receiving a constant

stream of changing images and displaying a current image, the method of the present invention

can receive and store a number of images in RAM 44 for access and display at a later time

(Grossman et al. 8:21-24). However, the Grossman et al. reference does not specifically disclose

storing first information element in a buffer and others in a memory wherein corresponding ones

of the others of the selected data sets stored in the memory of the digital set top box replace those

of the selected data in the buffer of the digital set top box once the first information element is

displayed. The Nathan et al. reference discloses button (1038) allows ordering of the selection

which is then downloaded according to the above-described mode (Nathan et al. 6:66-67). The

Nathan et al. reference also discloses a SPMM module allows the system to manage the musical

song or video selections in the queue for their playback in the order of selection (Nathan et al.

8:22-24). The Nathan et al. reference also discloses audio and display buffers (Nathan et al.;

Figure 2 "110,111"). The Nathan et al. reference discloses when the selection has been

reproduced in its entirety, it is removed from the queue file and the system checks if there are

others in the queue file. If there is another, the system immediately starts to play the selection

(Nathan et al. 9:54-57). Accordingly, the examiner submits that it would have been obvious to

one of ordinary skill in the art at the time the invention was made to modify the Grossman et al.

storing of interchannel messages with the Nathan et al. queue using a memory and buffer for the

purpose of displaying interchannel messages in order of receipt and a method for memory

management. Furthermore, the claimed is essentially a storage queue in addition to a buffer.

The examiner submits that the use of a queue in computer related devices is notoriously well

known and the use of a buffer is well known in the art for the purpose of providing data for

display in a more readily accessible manner and for memory management. The reference to

Nathan et al. was merely to show such well-known teachings.

In response to applicant's argument that the 35 U.S.C. 103 rejection of claim 7 is

erroneous, please refer to examiner's response to the combination of Picco and Grossman, and

with respect to the combination of Grossman with Kitsukawa as discussed above. Furthermore,

the examiner would like to point out that both the Grossman et al. and Tsuria reference disclose

inventions where advertisements are displayed during a channel change. However, the

Grossman et al. reference simply discloses several examples of advertising that may be displayed

during the channel changes but is silent as to the advertisements being associated with the data

stream information from the server. The Tsuria reference discloses advertisements during a

channel change and further teaches "[p]referably, the information message is associated with a

channel. The channel may be a channel which is currently viewed. Alternatively, the channel

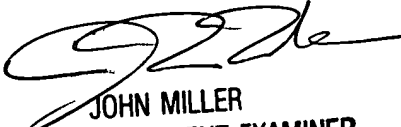may be a channel to which tuning is changed" (Tsuria 2:1-4).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Johnny Ma whose telephone number is (703) 305-8099. The

examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-HELP.

jm

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